



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,320	07/27/2001	Terry R. Bradfield	10559/471001/P10999	9550

20985 7590 12/10/2004

FISH & RICHARDSON, PC
12390 EL CAMINO REAL
SAN DIEGO, CA 92130-2081

EXAMINER

POLLACK, MELVIN H

ART UNIT	PAPER NUMBER
----------	--------------

2145

DATE MAILED: 12/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/917,320	Applicant(s) BRADFIELD ET AL.	
	Examiner Melvin H Pollack	Art Unit 2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>see attached office action</u> . |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: the definitions of such terms as “first data” and “satisfying an access requirement”, as well as whether it is the mobile device performing the reading and determining, or if it is the first resource, or another device within the first network device. In fact, one could interpret the phrasings to mean that the mobile device studied the response to a query to determine if the data matched the query. Alternatively, and based upon the specification, one could determine the claim to mean a first network device (i.e. access server) reads the data and determines if the access should be allowed. For the purposes of this office action, the examiner will assume the later definition, and will further assume that data is generic and can therefore be of any type.

4. Claims 2-4 suffer from similar problems.

5. Claims 5-20 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: the definitions of “sharing criteria”, “first data (see

above)", and "first network identifier." As shown in the above arguments, the lack of clarity of these terms leads to ambiguity and undue experimentation to determine the proper embodiment. Therefore, the applicant is required to clearly define the terms and/or amend the claims to clarify these issues. For the purposes of this office action, the examiner will assume that "sharing criteria" means a method of determining access to data. While first data and first network identifier may be read broadly to include a variety of options, the examiner will further assume for the purpose of this office action only that first data corresponds to authentication data such as user name and/or password, and that first network identifier may refer to any data regarding the user and/or device, but the examiner will concentrate on device IDs, IP addresses, and the like.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Cook (6,697,806).

8. For claim 1, Cook teaches a method (abstract; col. 1, line 1 – col. 6, line 15) comprising:

- a. Coupling a mobile (col. 9, line 7) device (Fig. 5, #512) associated with a first resource (Fig. 5, #530) to a first network environment (Fig. 5, #500; col. 8, line 50 – col. 9, line 50);
- b. Reading first data associated with the first network environment (Fig. 8, #804);

Art Unit: 2145

- c. Determining whether the first data satisfies a first access requirement stored locally at the mobile device (Fig. 8, #810); and
 - d. Allowing access to the first resource if the first data satisfies the first access requirement (Fig. 11, #1148).
- 9. For claim 2, Cook teaches that the method further comprises:
 - a. Obtaining second data associated with a particular user of the first network (Fig. 15);
 - b. Reading a second access requirement stored locally at the mobile device (Fig. 16); and
 - c. Determining if the second data satisfies the second access requirement before allowing access to the first resource (Fig. 16, #1612).
- 9. For claim 3, Cook teaches that the method further comprises:
 - a. Obtaining second data associated with a particular user of the first network after allowing access to the first resource (Fig. 25, #2502);
 - b. Reading a second access requirement stored locally at the mobile device and associated with a second resource after allowing access to the first resource (Fig. 26, #2624);
 - c. Determining if the second data satisfies the second access requirement (Fig. 26); and
 - d. Allowing access to the second resource if the second data satisfies the second access requirement (Fig. 26, #2626).
- 10. For claim 4, the method further comprises:

- a. Reading second data associated with a second network environment (col. 5, lines 5-11);
 - b. Determining whether the second data satisfies a second access requirement stored locally at the mobile device (col. 5, lines 12-20); and
 - c. Allowing access to a second resource associated with the mobile device if the second data satisfies the second access requirement (col. 3, line 50 – col. 4, line 22).
11. For claim 5, Cook teaches a method (abstract) of establishing and using sharing criteria to control access to a resource (col. 1, line 1 – col. 6, line 15) comprising:
 - a. Reading a first network identifier (col. 2, lines 55-60);
 - b. Receiving an indication that the resource is to be associated with the first network identifier (Fig. 14); and
 - c. Storing the first network identifier in a first association with a resource identifier that identifies the resource so that access to the resource is contingent upon receipt of the first network identifier (Fig. 15).
12. For claim 6, Cook teaches that the storing of the first network identifier in association with the resource identifier is accomplished by copying a portion of an association between the first network identifier and a second resource (col. 15, lines 10-30).
13. For claim 7, Cook teaches that the method further comprises:
 - a. Receiving a network identifier associated with an entity attempting to access the resource (col. 17, lines 1-10);
 - b. Comparing the received network identifier with the stored network identifier (col. 17, lines 10-25, esp. lines 21-22); and

Art Unit: 2145

- c. Allowing access to the resource if the received network identifier matches the stored network identifier (col. 17, lines 25-37).
- 14. For claim 8, Cook further teaches that the method further comprises denying access to the resource if the received network identifier does not match the stored network identifier (col. 17, lines 25-37).
- 15. For claim 9, Cook teaches that the method further comprises:
 - a. Receiving first data associated with a particular user (col. 3, lines 50-67);
 - b. Receiving an indication that the resource is to be associated also with the first data (Fig. 14); and
 - c. Storing the first data in a second association with the resource identifier so that the access to the resource is contingent also upon receipt of the first data (Fig. 7).
- 16. For claim 10, Cook teaches removing the first association between the first network identifier and the resource identifier so that access to the resource is allowed without receipt of the first network identifier (col. 4, lines 20-40).
- 17. For claim 11, Cook teaches that suspending temporarily the first association between the first network identifier and the resource identifier so that access to the resource is allowed without receipt of the first network identifier (col. 35, lines 50-65). "Predictive caching" is a method of allowing users access to a resource without having to utilize the login procedure or the first network identifier.
- 18. For claim 12, Cook teaches that the method further comprises:
 - a. Displaying a second network identifier (Fig. 5, #554);

Art Unit: 2145

- b. Receiving an indication that the resource is to be associated with the second network identifier (col. 4, lines 20-40); and
 - c. Storing the second network identifier in a second association with the resource identifier so that access to the resource is contingent upon receipt of either the first network identifier or the second network identifier (col. 4, lines 20-40).
19. Claims 13-20 are drawn to a software system that implements the method drawn in claims 5-12. It is well known in the art that a system implementation is functionally equivalent to the underlying method. Therefore, since claims 5-12 are rejected, claims 13-20 are also rejected for the reasons above. A teaching that shows the functional equivalence will be included upon request.

Conclusion

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin H Pollack whose telephone number is (571) 272-3887. The examiner can normally be reached on 8:00-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey can be reached on (571) 272-3896. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2145

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MHP

02 December 2004

THONG KH

